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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,241	01/05/2001	Kazumi Saburi	81922.0004	5876

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EXAMINER,

ENG, GEORGE

ART UNIT PAPER NUMBER

2643

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/743,241

Applicant(s)

SABURI ET AL.

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-27 is/are pending in the application.
- 4a) Of the above claim(s) 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-21 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office action is in response to the amendment filed 4/22/2004.

Election/Restrictions

2. Claims 22-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/25/2004.

A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 13-14, 17-18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irube et al. (US PAT. 6,377,818 hereinafter Irube) in view of Tagashira et al. (JP 05-145655A hereinafter Tagashira) and Yoshida (JP 04-010746A).

Regarding claim 13, Irube discloses a mobile communication terminal as shown in figure 1 having a telephone function, a data communication function and a visual telephone function (col. 4 lines 33-36) comprising a camera (4) including an image sensor which picks up images (col. 5 lines 64-66), a display unit (14) which displays images (col. 4 lines 16-25), and a control unit (11) which selects one of the operation functions (col. 9 line 46 through col. 10 line 16). Irube differs from the claimed invention in not specifically teaching a data type identify unit for identifying whether the received information, that is received from the outside of the mobile communication terminal when a call is received, is sound data, text data, or image data, based on a data information which was appended in advance as a header to received data, and a registering unit for storing a plurality of application programs including at least an application program for executing the visual telephone function. However, Tagashira teaches a multi-medium terminal equipment to enable information communication between proper media comprising storing means (5) for storing a plurality of application programs including at least an application program for executing multimedia communication, i.e., visual telephone function, comparison analysis circuit (6) for identifying whether the received data, that is received from the outside of the mobile communication terminal when a call is received, is sound data, text data, or image

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data, based on a data information which was appended in advance as a header to received data in order to enable the information communication between proper media, thereby prevent a reply to an incoming call to undesired media (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Irube in having the data type identify unit and the registering unit, as per teaching of Tagashira, because it prevents the reply to an incoming call to undesired media. Furthermore, neither Irube nor Tagashira specifically teaches a control unit for selecting one of the application programs including correspondence with the data type information that is appended to incoming information and is identified by the data type identification unit and activating the selected application program. However, it is old and notoriously well known in the art of a communication equipment comprising means for selecting one of the communication modes, i.e., application programs, in accordance with the output of detecting means at the time of an incoming call in order to automatically select the other communication in accordance with a prescribed communication condition, for example see Yoshida (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Irube and Tagashira in having the control means for selecting one of the application programs including correspondence with the data type information that is appended to incoming information and is identified by the data type identification unit and activating the selected application program, as per teaching of Yoshida, in order to automatically select the other communication in accordance with a prescribed communication condition, thereby makes more user friendly.

Regarding claim 14, Tagashira teaches the terminal equipment for communicating multi-medium (abstract) so that it recognizes the plurality of application program including an application for executing a telephone function and an application program for executing a data communication function.

Regarding claim 17, Irube discloses a mobile communication terminal as shown in figure 1 having a telephone function, a data communication function and a visual telephone function (col. 4 lines 33-36) comprising a body (1), a detachable image unit (4) having an image sensor which is detachable to the body (col. 5 lines 64-66), a display unit (14) which displays images (col. 4 lines 16-25), a video telephone controller unit (25) for enabling the visual telephone function when the detachable imaging unit is attached to the body (col. 5 line 64 through col. 6 line 4) and a control unit (11) which selects one of the operation functions (col. 9 line 46 through col. 10 line 16). Irube differs from the claimed invention in not specifically teaching a data type identify unit for identifying whether the received data is sound data, text data, or image data, based on a data information which was appended in advance as a header to received data, and a registering unit for storing a plurality of application programs including at least an application program for executing the visual telephone function. However, Tagashira teaches a multi-medium terminal equipment to enable information communication between proper media comprising storing means (5) for storing a plurality of application programs including at least an application program for executing multimedia communication, i.e., visual telephone function, comparison analysis circuit (6) for identifying whether the received data is sound data, text data, or image data, based on a data information which was appended in advance as a header to received data in order to enable the information communication between proper media, thereby

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prevent a reply to an incoming call to undesired media (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Irube in having the data type identify unit and the registering unit, as per teaching of Tagashira, because it prevents a reply to an incoming call to undesired media. Furthermore, neither Irube nor Tagashira specifically teaches a control unit for selecting one of the application programs including correspondence with the data type information that is appended to incoming information and is identified by the data type identification unit and activating the selected application program. However, it is old and notoriously well known in the art of a communication equipment comprising means for selecting one of the communication modes, i.e., application programs, in accordance with the output of detecting means at the time of an incoming call in order to automatically select the other communication in accordance with a prescribed communication condition, for example see Yoshida (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Irube and Tagashira in having the control means for selecting one of the application programs including correspondence with the data type information that is appended to incoming information and is identified by the data type identification unit and activating the selected application program, as per teaching of Yoshida, in order to automatically select the other communication in accordance with a prescribed communication condition, thereby makes more user friendly.

Regarding claim 18, the limitations of the claim are rejected as the same reasons set forth in claim 14.

Regarding claim 25, Irube discloses the detachable image unit (4) connected to the body (1) through the camera interface (25) so that the body obviously comprises a card slot section (100) and the detachable image unit obviously comprises a slot connector in order to connect the body with the detachable image unit (col.5 line 64 through col. 6 line 17).

5. Claims 15-16 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irube et al. (US PAT. 6,377,818 hereinafter Irube) in view of Tagashira et al. (JP 05-145655A hereinafter Tagashira) and Yoshida (JP 04-010746A) as applied in claims above, and further in view of Nishino et al. (JP 01-311744A hereinafter Nishino).

Regarding claims 15-16, the combination of Irube, Tagashira and Yoshida differs from the claimed invention in not specifically teaching to display contents of the data type information prior to line connection after receiving the received data. However, Nishino teaches to attain interconnection between a composite terminal equipment and other terminal equipment comprising a display unit for displaying content of the data type information prior to line connection after receiving a received data in order to notify a called party whether a calling party is a simple terminal equipment or a composite terminal equipment (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Irube, Tagashira and Yoshida displaying contents of the data type information prior to line connection after receiving the received data, as per teaching of Nishino, because it enhances the mobile communication terminal so that it is able to notify the called party whether the calling party is a simple terminal equipment or a composite terminal equipment. Although neither Irube, Tagashira, Yoshida nor Nishino does not specifically

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teaching to audibly output contents of data type information via a sound output unit, it is notoriously old and well known in the art of changing the form of notification by modifying visual notification to audio notification in order to make user friendly. Note while Nishino clearly teaches to visually display content of the data type information prior to line connection. Thus, a person of ordinary skill in the art would find obvious to audibly output contents of data type information instead of displaying contents of data type information in order to make user friendly.

Regarding claims 19-20, the limitations of the claims are rejected as the same reasons set forth in claims 15-16.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Irube et al. (US PAT. 6,377,818 hereinafter Irube) in view of Tagashira et al. (JP 05-145655A hereinafter Tagashira) and Yoshida (JP 04-010746A) as applied in claims above, and further in view of Tokano (US PAT. 5,838,577).

Regarding claim 21, the combination of Irube, Tagashira and Yoshida differs from the claimed invention in not specifically teaching an attachment status detecting unit for detecting whether the detachable imaging unit is attached to the body and the control unit visually or audibly informs a message suggesting attachment of the detachable image unit when the attachment status detecting unit has determined that the detachable image unit is not attached to the body. However, Tokano teaches an electrical apparatus for connecting to plural kinds of peripheral devices comprising disconnect status detecting unit (15, figure 5) for detecting whether a peripheral device is attached to the electrical apparatus and notification means for

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displaying a message indicating that the peripheral device is disconnected when the peripheral device is not attached to the electrical apparatus (col. 5 lines 47-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Irube, Tagashira and Yoshida in having the attachment status detecting unit for detecting whether the detachable imaging unit is attached to the body and the control unit visually or audibly informs a message suggesting attachment of the detachable image unit when the attachment status detecting unit has determined that the detachable image unit is not attached to the body, as per teaching of Tokano, because it makes user friendly so that it notifies the user whether the peripheral device is attached to the electrical apparatus or not.

7. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irube et al. (US PAT. 6,377,818 hereinafter Irube) in view of Tagashira et al. (JP 05-145655A hereinafter Tagashira) and Yoshida (JP 04-010746A) as applied in claims above, and further in view of Rostoker et al. (US PAT. 5,793,416 hereinafter Rostoker).

Regarding claims 26-27, the combination of Irube, Tagashira and Yoshida differs from the claimed invention in not specifically teaching a visual telephone system comprising a base station which sends to the mobile communication terminal data including data type information as a header. However, it is old and notoriously well known in the art of wireless communication system using a base station for establishing communications between mobile communication terminals such that the base station is capable of sending data including a data type information as a header to a mobile communication terminal, for example see Rostoker (abstract and col. 2 line 53 through col. 3 line 43). Therefore, it would have been obvious to a person of ordinary

skill in the art at the time the invention was made to modify the combination of Irube, Tagashira and Yoshida in having the base station, as per teaching of Rostoker, in order to establish communications between mobile communication terminals.

Response to Arguments

8. Applicant's arguments filed 4/22/2004 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's arguments that the references fail to disclose or suggest a control unit, which selects one of the application programs in correspondence with the data-type information, which is appended to incoming information and is identified by an identifying unit, and activates the selected application program, Yoshida clearly teaches a communication equipment having control means (i.e., the control unit) for selecting either one of the communication modes (i.e., application programs) in accordance with an output (i.e., data-type information) of a detecting means (i.e., identifying unit) at the time of an incoming call. Thus, one skill in the art would recognize Yoshida teaching the control means for selecting one of the communication modes including correspondence with the data type information that is appended to incoming information and activating the selected communication mode. As a result, the combination of Irube, Tagashira and Yoshida is enough to reject the claimed limitations.

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Irube, Tagashira and Yoshida are combinable because they are in the same field of endeavor, i.e., operating multi-medium communications on communication terminal equipment. The motivation of combining Tagashira with Irube is to enable the information communication between proper media and to prevent a reply to an incoming call to undesired media, and the motivation of combining Yoshida and the combination of Irube and Tagashira is to automatically select one of the communication modes in accordance with a detected output received from an incoming call for surely attaining data communication and sound communication. Thus, the independent claims 13 and 17 are not patentable over the cited references.

In response to applicant's argument that Tokano fails to teach an attachment status detecting unit detecting whether a detachable imaging unit is attached to a body, and the control unit visually informs a message suggesting attachment of the detachable image unit when the detachable unit is not attached to the body, Tokano clearly teaches an electrical apparatus for connecting to plural kinds of peripheral devices comprising detecting means (i.e., the attachment status detecting unit) for detecting whether a peripheral device is attached to the electrical apparatus and notification means (i.e., control unit) for displaying a visually message indicating

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that the peripheral device is disconnected when the peripheral device is not attached to the electrical device. The motivation of combining Tokano with the combination of Irube, Tagashira and Yoshida is to make user friendly by notifying a use of the attachment status of the peripheral device.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



George Eng
Primary Examiner
Art Unit 2643